

Application Number : 10/676,572
Appellant : Stuart D. Cheshire
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Examiner : Hamza, Faruk

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Appeal Brief
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APPEAL BRIEF

Sir:

In response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed 16 June 2011, and subsequent to the Notice of Appeal filed 02 May 2011, Appellant submits this Appeal Brief to appeal the rejection of independent claims 1, 9, and 17 under 35 U.S.C. § 112 and 35 U.S.C. § 103. This Appeal Brief demonstrates that such rejections cannot be sustained because the Examiner has not established a *prima facie* case of the indefiniteness of the claims under 35 U.S.C. § 112, and has not established a *prima facie* case of obviousness under 35 U.S.C. § 103.

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THE REAL PARTY IN INTEREST

The real party in interest in this appeal is Apple, Inc.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals and/or interferences.

For completeness, Appellant notes the following cases that claim priority from the instant application, or from which the instant application claims priority:

1. The instant application claims priority to now-expired provisional patent application 60/496,843, filed 20 August 2003.
2. PCT/US04/13646, filed on 29 April 2004, claims the benefit of the instant application.

STATUS OF CLAIMS

The status of the claims is as follows:

Claims pending:	1, 5-9, 13-17, 21-24, 35-37, and 41-43
Claims rejected:	1, 5-9, 13-16, 21-24, 35-37, and 41-43
Claims allowable:	5-7, 13-15, and 21-23*
Claims cancelled:	2-4, 10-12, 18-20, 25-34, and 38-40
Claims appealed:	1, 9, and 17

*marked as allowable despite also being rejected under 35 U.S.C. § 112

STATUS OF AMENDMENTS

All amendments have been entered. A copy of the rejected claims is attached as appendix A.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent Claim 1: A Method for Invalidating Resource Records in a Local Cache at a Client Computer System within a Network

Receiving a multicast message from another client querying a device in the claimed embodiments is described in at least paragraph [0031] and FIG. 4 of the instant application. Locating a resource record associated with the device in the claimed embodiments is described in at least paragraph [0031] and FIG. 4 of the instant application. Waiting for a multicast response from the device to the multicast message querying the device in the claimed embodiments is described in at least paragraph [0031] and FIG. 4 of the instant application. When a predetermined number of multicast messages from the other client querying the device have been received without receiving the multicast response from the device to the other client, invalidating the resource record associated with the device in the claimed embodiments is described in at least paragraph [0031] and FIG. 4 of the instant application.

Independent Claim 9: A Computer-Readable Storage Medium

Independent claim 10 is generally directed toward a computer-readable storage medium, which is described in at least paragraph [0021] of the instant application. Independent claim 10 includes subject matter generally similar to that of independent claim 1. Because the summary of claim 1 is sufficient to determine the support in the instant application for claim 10, Appellant does not herein repeat that summary.

Independent Claim 17: An Apparatus

Independent claim 19 is generally directed toward an apparatus, which is described in at least paragraphs [0022]-[0024] of the instant application.

Independent claim 19 includes subject matter generally similar to that of independent claim 1. Because the summary of claim 1 is sufficient to determine the support in the instant application for claim 19, Appellant does not herein repeat that summary.

GROUND OF REJECTION PRESENTED FOR REVIEW

In the Official Action mailed **30 December 2010** (hereinafter “1210 OA”), the Examiner reviewed claims 1, 5-9, 13-16, 21-24, 35-37, and 41-43. The Examiner rejected claims 1, 5-9, 13-16, 21-24, 35-37, and 41-43 under 35 U.S.C. § 112. The Examiner rejected claims 1, 8-9, 16-17, 24, and 41-43 under 35 U.S.C. § 103(a) based on Danknick et al. (U.S. pat. no. 6,021,429, hereinafter “Danknick”) in view of Eatough (U.S. pub. no. 2003/0050955, hereinafter “Eatough”). The Examiner rejected claims 35-37 under 35 U.S.C. § 103(a) based on Danknick and Eatough in view of George (U.S. pat. no. 7,143,108, hereinafter “George”). In addition, in the 1210 OA, the Examiner objected to claims 5-7, 13-15, and 21-23 as being dependent upon a rejected base claim, but pointed out that these claims would be allowable if rewritten in independent form. However (and as described above), the Examiner also rejected the claims that the Examiner indicates are allowable under 35 U.S.C. § 112 in the 1210 OA.

In an Advisory Action mailed **21 March 2011** (hereinafter “0311 AA”), the Examiner maintained rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103, and made further remarks.

For the purposes of this appeal, and without admission as to the appropriateness of the other grounds raised by the Examiner, Appellants will address the Examiner’s rejection of independent claims 1, 9, and 17 under 35 U.S.C. § 112. Appellants will show that the claim term indicated by the Examiner has sufficient antecedent basis.

Appellants will also address the Examiner’s reliance on Danknick in rejecting independent claims 1, 9, and 17 in the instant application under 35 U.S.C. § 103. Appellants will show that the Examiner improperly attributes

principles of operation to Danknick that are nowhere described in Danknick,¹ and that the gap between Danknick and the claimed embodiments is sufficiently large that one having skill in the art would not find the claimed embodiments obvious in light of Danknick.² More specifically, Appellants will show that Danknick does not describe or suggest the communication between devices claimed in independent claims 1, 9, and 17.

Because the indicated claim term has sufficient antecedent basis, and because Danknick does not describe the claimed embodiments, the Examiner has not properly established a *prima facie* case of the indefiniteness and/or obviousness of these claims. Accordingly, the Examiner has erred in rejecting these claims, and the rejection of these claims under 35 U.S.C. § 112 and 35 U.S.C. § 103 cannot be sustained.

1 see, e.g., MPEP § 2143.01(VI), as “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)”

2 see, e.g., MPEP § 2141(III), as “The prior art [references] need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art ... The gap between the prior art and the claimed invention may not be ‘so great as to render the [claim] nonobvious to one reasonably skilled in the art.’”

ARGUMENTS

Rejections of Independent Claims 1, 9, and 17 under 35 U.S.C. § 112

In the 0311 AA, the Examiner made the following remark regarding the amendments in the office action response filed 10 March 2011:

Claims 1, 8, 9, 16, 17, 24, 35-37 and 41-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 9 and 17 recite the limitation "the other client". There is insufficient antecedent basis for this limitation in the claim.³

Appellant respectfully disagrees with the rejection. The usage of the term "the other client" after referring to "another client" does not render the claim indefinite. The claim is not indefinite because common spoken usage renders the terms related clearly enough for a person having ordinary skill in the art to recognize their equivalence and thereby to determine the scope of the claimed embodiments.⁴

Thus, the Examiner has not properly established a *prima facie* case of the indefiniteness of claims 1, 9, and 17. Accordingly, the Examiner has erred in rejecting these claims, and the rejection of these claims under 35 U.S.C. § 112 cannot be sustained. Appellant therefore respectfully requests that the Board overturn the rejection of claims 1, 9, and 17 under 35 U.S.C. § 112.

Rejections of Independent Claims 1, 9, and 17 under 35 U.S.C. § 103

In rejecting independent claims 1, 9, and 17 in the instant application, the Examiner argued as follows (using the rejection of claim 1 as exemplary):

³ see 0311 AA, page 2

⁴ see at least MPEP § 2173.02, as "In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent"

As to claim 1, **Danknick teaches** a method for invalidating a resource record in a local cache at a client computer system within a network, comprising: receiving a message from a second client querying a device; locating a second resource record associated with the second device; waiting for a response to the multicast query; and if after a pre-determined number of queries the response to the query is not received in the pre-determined amount of time, invalidating the second resource record (Column 8, lines 1-Column 9, lines 8).⁵

Appellant respectfully disagrees with this rejection. Although describing a network device that can be configured to function as a “list manager,” Danknick nowhere describes the claimed embodiments.

In the Danknick system, a device on a local-area network (LAN) can be configured in one of two ways -- either as a “list manager” for the LAN or as a “slave device” on the LAN.⁶ In the Danknick system, when a device is configured as a list manager, the device “creates and stores a list of devices” and provides other (slave) devices with the stored list of devices.⁷ For example, Danknick provides the following explanation:

If, on the other hand, NEB 2 receives the device address of the other network device, processing proceeds to step S511 in which NEB 2 **adds the device address of that other network device to the list of device addresses** in NEB 2. The device address is preferably added to the bottom of the list, although it may be added elsewhere as desired;⁸

Regarding the list of device addresses, a list manager on LAN 1 (which may or may not be NEB 2) maintains a list of device addresses from other devices on LAN 1. The list typically includes device addresses and corresponding device identification information for each device address ... Examples of device addresses and identification information **stored in a memory** on NEB 2 are shown in FIG. 8;⁹ and

⁵ see 0311 AA, page 2

⁶ see Danknick, col. 1, lines 41-50

⁷ see *id.*, FIG. 5B, elements S506 and S521, and cols. 9-12

⁸ see *id.*, col. 10, lines 15-24

⁹ see *id.*, col. 7, line 57-col. 8, line 6

In step S520 NEB 2 determines whether a peripheral on LAN 1, such as PC 26, has requested the list of device addresses stored in NEB 2. If, in step S520, NEB 2 determines that a peripheral has requested its list of device addresses, NEB 2 **provides the peripheral with the list of device addresses** in step S521.¹⁰

Thus, Danknick describes a device that (when configured as a list manager) creates and stores a list of devices on the LAN, and provides the list of devices to other peripheral devices on request.

However, Danknick nowhere describes an interaction between *three* entities, i.e., (1) a client computer system; (2) another client; and (3) a device, such as in the claimed embodiments. Specifically, Danknick nowhere describes (1) **a client computer system** receiving a multicast message from (2) **another client** querying (3) **a device**, wherein (1) the **client computer system** subsequently invalidates a resource record in (1) the **client computer system** if a predetermined number of multicast messages from (2) **the other client** querying (3) **the device** have been received without receiving the multicast response from (3) **the device** to (2) **the other client**. One having skill in the art can clearly determine that **the client computer system** in the claimed embodiments performs the invalidation operation **based on communications** between **the other client and the device**.

Because Danknick does not describe the claimed embodiments for at least the reasons set forth above, the Examiner improperly attributes principles of operation to Danknick that are nowhere described in Danknick. Moreover, the gap between Danknick and the claimed embodiments is sufficiently large that one having skill in the art would not find the claimed embodiments obvious in light of Danknick. Thus, the Examiner has not properly established a *prima facie* case of the obviousness of claims 1, 9, and 17. Accordingly, the Examiner has erred in

¹⁰ see *id.*, col. 11, lines 59-64

rejecting these claims, and the rejection of these claims under 35 U.S.C. § 103 cannot be sustained. Appellant therefore respectfully requests that the Board overturn the rejection of claims 1, 9, and 17.

Conclusion

Because the Examiner has not properly established a *prima facie* case of the indefiniteness of independent claims 1, 9, and 17, the Examiner has erred in rejecting these claims, and the rejection of these claims under 35 U.S.C. § 112 cannot be sustained. Additionally, because the Examiner has not properly established a *prima facie* case of the obviousness of independent claims 1, 9, and 17, the Examiner has erred in rejecting these claims, and the rejection of these claims under 35 U.S.C. § 103 cannot be sustained. Moreover, by reason of the dependency of the dependent claims on independent claims 1, 9, and 17, the rejection of the dependent claims cannot be sustained. Appellant therefore respectfully requests that the Board overturn the rejection of all of the claims in the instant application.

Respectfully submitted,

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APPENDICES

Appendix A: Claims Appendix

1 1. (Previously Presented) A method for invalidating resource records
2 in a local cache at a client computer system within a network, comprising:
3 receiving a multicast message from another client querying a device;
4 locating a resource record associated with the device;
5 waiting for a multicast response from the device to the multicast message
6 querying the device; and
7 when a predetermined number of multicast messages from the other client
8 querying the device have been received without receiving the multicast response
9 from the device to the other client, invalidating the resource record associated
10 with the device.

1 2-4. (Canceled).

1 5. (Previously Presented) The method of claim 41, wherein if the
2 response to the issued query is not received in a pre-determined amount of time,
3 the method further comprises:
4 retrieving a parent record of the resource record at the client, wherein the
5 parent record refers to the resource record;
6 issuing a query for the parent record;
7 waiting for a response to the query from the device; and
8 if the response to the query is not received in a pre-determined amount of
9 time, invalidating the parent record, and then repeating the above process by
10 applying it recursively to any records that refer to the now-invalidated parent
11 record.

1 6. (Previously Presented) The method of claim 41, wherein if the
2 response to the issued query is not received in a pre-determined amount of time,
3 the method further comprises:
4 retrieving a parent record of the resource record at the client, wherein the
5 parent record refers to the resource record;
6 issuing a query for the parent record;
7 receiving a response to the query from the device, wherein the response
8 includes information for updating the resource record; and
9 updating the resource record with the information received in the response.

1 7. (Original) The method of claim 6, wherein the method further
2 comprises updating the parent record with the information received in the
3 response.

1 8. (Previously Presented) The method of claim 41, wherein the
2 resource records are retrieved and the queries are issued at a pre-specified time
3 interval.

1 9. (Previously Presented) A computer-readable storage medium
2 storing instructions that when executed by a computer cause the computer to
3 perform a method for invalidating resource records in a local cache at a client
4 computer system within a network, the method comprising:
5 receiving a multicast message from another client querying a device;
6 locating a resource record associated with the device;
7 waiting for a multicast response to the multicast message querying the
8 device; and

9 when a predetermined number of multicast messages from the other client
10 querying the device have been received without receiving the multicast response
11 from the device to the other client, invalidating the resource record associated
12 with the device.

1 10-12. (Canceled).

1 13. (Previously Presented) The computer-readable storage medium of
2 claim 42, wherein if the response to the issued query is not received in a pre-
3 determined amount of time, the method further comprises:
4 retrieving a parent record of the resource record at the client, wherein the
5 parent record refers to the resource record;
6 issuing a query for the parent record;
7 waiting for a response to the query from the device; and
8 if the response to the query is not received in a pre-determined amount of
9 time, invalidating the parent record, and then repeating the above process by
10 applying it recursively to any records that refer to the now-invalidated parent
11 record.

1 14. (Previously Presented) The computer-readable storage medium of
2 claim 42, wherein if the response to the issued query is not received in a pre-
3 determined amount of time, the method further comprises:
4 retrieving a parent record of the resource record at the client, wherein the
5 parent record refers to the resource record;
6 issuing a query for the parent record;
7 receiving a response to the query from the device, wherein the response
8 includes information for updating the resource record; and
9 updating the resource record with the information received in the response.

1 15. (Original) The computer-readable storage medium of claim 14,
2 wherein the method further comprises updating the parent record with the
3 information received in the response.

1 16. (Previously Presented) The computer-readable storage medium of
2 claim 42, wherein the resource records are retrieved and the queries are issued at a
3 pre-specified time interval.

1 17. (Previously Presented) An apparatus that invalidates resource
2 records in a local cache at a client computer system within a network, comprising:
3 an invalidation mechanism configured to:
4 receive a multicast message from another client querying a device;
5 receive a resource record associated with the device from the
6 retrieval mechanism in response to receiving the multicast message;
7 wait for a multicast response to the multicast message querying the
8 device; and
9 when a predetermined number of multicast messages from the
10 other client querying the device have been received without receiving the
11 multicast response from the device to the other client, invalidate the
12 resource record associated with the device.

1 18-20. (Canceled).

1 21. (Previously Presented) The apparatus of claim 43, wherein if the
2 response to the issued query is not received in a pre-determined amount of time,
3 the invalidation mechanism is additionally configured to:

4 retrieve a parent record of the resource record at the client, wherein the
5 parent record refers to the resource record;
6 issue a query for the parent record;
7 wait for a response to the query from the device; and
8 if the response to the query is not received in a pre-determined amount of
9 time, to invalidate the parent record, and to then repeat the above process by
10 applying it recursively to any records that refer to the now-invalidated parent
11 record.

1 22. (Previously Presented) The apparatus of claim 43, further
2 comprising an updating mechanism, wherein if the response to the issued query is
3 not received in a pre-determined amount of time, the updating mechanism is
4 configured to:

5 retrieve a parent record of the resource record at the client, wherein the
6 parent record refers to the resource record;
7 issue a query for the parent record;
8 receive a response to the query from the device, wherein the response
9 includes information for updating the resource record; and to
10 update the resource record with the information received in the response.

1 23. (Original) The apparatus of claim 22, wherein the updating
2 mechanism is additionally configured to update the parent record with the
3 information received in the response.

1 24. (Previously Presented) The apparatus of claim 43, wherein the
2 invalidation mechanism is configured to retrieve resource records and issue
3 queries at a pre-specified time interval.

1 25–34. (Canceled).

1 35. (Previously Presented) The method of claim 1 wherein invalidating
2 the resource record further comprises invalidating a child resource record of the
3 resource record.

1 36. (Previously Presented) The computer-readable storage medium of
2 claim 9, wherein invalidating the resource record further comprises invalidating a
3 child resource record of the resource record.

1 37. (Previously Presented) The apparatus of claim 17, wherein
2 invalidating the resource record further comprises invalidating a child resource
3 record of the resource record.

1 38–40. (Canceled).

1 41. (Previously Presented) The method of claim 1, wherein the method
2 further comprises:
3 retrieving a resource record from the local cache at the client computer
4 system;
5 issuing one or more queries for the resource record at the client computer
6 system;
7 waiting for a response to the query at the client computer system; and
8 if the response to the query is not received in a pre-determined amount of
9 time and after issuing a predetermined number of queries for the resource record,
10 invalidating the resource record at the client computer system

1 42. (Previously Presented) The computer-readable storage medium of
2 claim 9, wherein the method further comprises:
3 retrieving a resource record from the local cache at the client;
4 issuing one or more queries for the resource record;
5 waiting for a response to the query; and
6 if the response to the query is not received in a pre-determined amount of
7 time and after issuing a predetermined number of queries for the resource record,
8 invalidating the resource record at the client.

1 43. (Previously Presented) The apparatus of claim 17, wherein the
2 apparatus further comprises:
3 a retrieval mechanism at the client configured to retrieve a resource record
4 from the local cache at the client, wherein the invalidation mechanism is
5 configured to:
6 issue one or more queries for the resource record,
7 wait for a response to the query, and
8 if the response to the query is not received in a pre-determined
9 amount of time and after issuing a predetermined number of queries for
10 the resource record, invalidate the resource record at the client.

Appendix B: Evidence

None.

Appendix C: Related Proceedings

None.